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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,184	10/18/2001	Michael A. Pellico	45191/WPC/D279	4838
23363	7590	11/30/2004	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			KRASS, FREDERICK F	
PO BOX 7068			ART UNIT	PAPER NUMBER
PASADENA, CA 91109-7068			1614	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/045,184	<b>Applicant(s)</b> PELLICO, MICHAEL A.	
	<b>Examiner</b> Frederick F. Krass	<b>Art Unit</b> 1614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 and 17-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Obviousness Rejection**

1) Claims 1-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ostler (USP 6,116,900) in view of Jensen et al (USP 5,858,332).

This rejection is maintained and is now applicable to claims 1-10 and 17-23.

Applicant argues that no case of obviousness exists because the secondary reference is "mainly concerned" with a one-component composition having sufficient shelf life, not a two component system as claimed instantly. This argument is not found persuasive; the prior art teaching that bleaching activity can be varied by adjusting the relative proportions of carbamide peroxide and hydrogen peroxide is a generic one, and relates to the activity of the peroxides upon their application to teeth, not their activity while in storage. Accordingly, the teaching is relevant to bleaching compositions generally, be they one or two part.

Applicant also argues that the secondary reference "teaches away" from combining carbamide and hydrogen peroxide because it states that "it will be preferable to use concentrated hydrogen peroxide solutions when it is desired to manufacture a bleaching composition having high concentrations of bleaching agent." This argument is not understood. The reference clearly does disclose combining the two peroxides, and the teaching at issue merely relates to mixtures at the high end of the scale, i.e. those comprising predominantly hydrogen peroxide and containing only minor amounts of carbamide peroxide. This is merely an exemplification of one particular embodiment, not a "teaching away" from the general concept.

Regarding newly added claims 17-23, these claims merely recite conventional ingredients for bleaching gels, all of which are disclosed by one or both of the primary and secondary references. Moreover, the selection of appropriate/optimal percentages of each is well within the skill of the ordinary artisan.

2) Claims 1, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostler in view of Jensen, the combination being taken further in view of Norfleet et al (USP 5,486,350).

This rejection is maintained and is now applicable to claims 1, 11, 12 and 24-27.

Applicant argues that the primary and secondary references are not properly combinable for the reasons discussed in subsection "1)" supra, and that even if they were the tertiary reference does not cure their deficiencies since it merely mentions additives such as fluoride and potassium nitrate, but does not provide the requisite motivation for incorporating them into the instant compositions.

The examiner does not agree. No unobviousness is seen in incorporating ingredients well known in the dental bleaching art for their known, art-recognized purpose, namely to increase patient comfort by reducing tooth sensitivity. Surely this is sufficient motivation for anyone skilled in the art to do so; patient comfort is always of the highest priority. The tertiary reference is cited merely to demonstrate that same is in fact well-known in the art, and not an unsupported assertion by the examiner.

Regarding newly added claims 24-27, these claims merely recite conventional ingredients for bleaching gels, all of which are disclosed by one or both of the primary and secondary references. Moreover, the selection of appropriate/optimal percentages of each is well within the skill of the ordinary artisan.

#### **Allowable Subject Matter**

Claims 13 remains allowable as presently advised.

#### **Suggested Amendment**

In reviewing the prior art in light of Applicant's arguments, the examiner notes that both the primary and secondary references prefer or require the incorporation of radiant or heat-energy absorbing

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activators. See for example Jensen et al at the first paragraph of col. 4, and col. 8, lines 12-26, and at col. 9, lines 37-46; see also Ostler at the passage spanning col. 3, line 58 to col. 4, line 10, and col. 6, lines 29-56.

The instant specification, by contrast, specifically teaches that the instant compositions should be free of radiant-energy or heat-energy absorbing activator substances. See page 3, lines 26 and 27. Were this limitation to be placed in the instant claims, they would then be drawn to allowable subject matter because it would not have been obvious to have added carbamide peroxide to hydrogen peroxide, since the former would be expected to reduce the activity of the latter. Stated alternatively, Applicant varies the bleaching activity of hydrogen peroxide by adding carbamide peroxide thereto, a generally known concept, but has unexpectedly discovered that when this is done in two part systems there is no longer any need to include an activator, as was required for one part systems (those of Jensen et al).

Applicant is warned, however, to be careful in drafting any such claims since it appears that fumed silica, recited by instant claims 24-27, is in fact a heat-energy absorbing activator. See Ostler at col. 6, line 52, for example.

#### **Action is Final**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick F. Krass whose telephone number is 571-272-0580. The examiner's schedule is as follows:

Monday: 10:30AM- 7PM;  
Tuesday: 10:30AM - 7PM;  
Wednesday: off;  
Thursday: 10:30AM- 7PM; and  
Friday: 10:30AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached at 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frederick Krass  
Primary Examiner  
Art Unit 1614

